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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/822,071	03/20/97	KEMPF	D 4861 US.D36
EXAMINER			

12M1/0917

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TRAVELER	PAPER NUMBER
1205	4

DATE MAILED: 09/17/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 3/20/97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 29-52 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 29-52 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING

Art Unit:

The amendment filed March 20, 1997 has been received and entered into the file.

Claims 29-52 are presented for examination.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art

Art Unit:

7) the predictability of the art, and

8) the breadth of the claims.

Applicant fails to set forth the criteria that defines all HIV protease inhibitors.

Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these compounds without undue experimentation. In the instant case, only a limited number of HIV protease inhibitor examples are set forth, thereby failing to provide sufficient working examples.

It is noted that these examples are neither exhaustive, nor define the class of compounds required.

The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all HIV protease inhibitors, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation. claims, thus is properly rejected under 35 USC 112, second paragraph.

Claims 29, 34, 36 and 43-45 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 48-52 are rejected under 35 U.S.C. § 101 as being non-statutory. The instant claim recites the "use of a material". A claim drafted in terms of use is improper since "the law does not permit the claiming of such an invention in terms of use" (*Clinical Products Ltd. v.*

Art Unit:

Brenner, Comr. Pats., 149 USPQ 475 (D.C.Cir. 1966) @ 478). Thus, claims 48-52 being non-statutory is withdrawn from further consideration.

Claims 28-33, 35, 37-42 and 46-47 are objected to as dependant on rejected claims. These claims would be allowable if written in independent form incorporating all limitations embodied in the independent claim.

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

Russell Travers
Primary Examiner
Art Unit 1205